

## REMARKS

Favorable reconsideration and withdrawal of the rejection set forth in the above-mentioned Official Action in view of the foregoing amendments and the following remarks are respectfully requested.

### Claims Status

Claims 1 and 9 remain pending in the application. Claims 3, 4, and 6 through 8 have been canceled. Claim 1 has been amended to even more succinctly define the invention and/or to improve their form. It is respectfully submitted that no new matter has been added.

### Section 103 Rejection

Claims 1, 3, 4, and 6 through 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chigono, et al. in view of Kukimoto, et al., Haneda, et al., Kato, et al., Van Nostrand's Scientific Encyclopedia, and Yamamoto, et al.

The rationale underlying the foregoing rejection is set forth in the Official Action.

### Traversal of Rejection

The rejection is respectfully traversed.

Chigono, et al. describes a one-component magnetic toner. See column 9, lines 59 through 64. The magnetic toner is produced through a pulverization step, and does not undergo surface treatment. Hence, a circularity of the particles making up the magnetic toner is less than 0.950.

A magnetic toner including particles having an average circularity of 0.930 is discussed in Comparative Example 1 at page 43, line 23 to page 44, line 12 of the specification. As clearly seen from studying Comparative Example 1 and Example 1, an

image-forming apparatus, which uses a magnetic toner having an average circularity of 0.950 or more, is particularly effective for large volume printing. (See page 45, lines 6 through 13; page 46, line 23 through page 47, line 8, and Table 1 at page 47 in the specification.)

It is again respectfully submitted that the combination rejection is not well founded. The Examiner has still not shown where in the cited art there is any suggestion or motivation in the cited art *per se* to cause one having ordinary skill in the art to combine the teachings of the cited art. For example, the Examiner notes that Chigono, et al. does not disclose the value of an average circularity of toner particles.

The Examiner also notes that Kato, et al. discloses toner having a circularity value in the claimed range and argues that the teachings of Chigono, et al., which as above-noted is silent as to average circularity, can be modified with the teachings of Kato, et al. because to do so would result in superior triboelectric charging performance. However, the Examiner has not provided any underlying support in the art for the proposition that one having ordinary skill in the art would modify the teaching of Chigono, et al. with the teachings of Kato, et al.

It is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness and the rejection should be withdrawn.

In view of the foregoing, it is respectfully submitted that independent Claims 1 and 9 are allowable over the cited art whether taken individually or in combination.

#### Dependent Claims

Claims 3, 4, and 6 through 8 depend either directly or indirectly from one of Claims 1 and 9 and are allowable by virtue of their dependency and in their own right for further

defining Applicants' invention. Individual consideration of the dependent claims is respectfully requested.

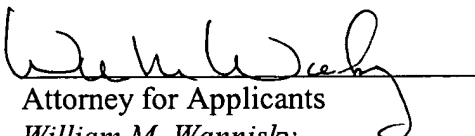
Closing Comments

This Amendment could not have been presented earlier in the prosecution, inasmuch as it was earnestly believed that the claims heretofore on file were in condition for allowance. It is believed that the Examiner's familiarity with the present application will allow full consideration hereof without the expenditure of undue time and effort.

Favorable reconsideration and early passage to issue of the present application are earnestly solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our New York office at the address shown below.

Respectfully submitted,

  
Attorney for Applicants  
*William M. Wannisky*  
Registration No. 28,373

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

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